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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,674	10/08/1999	JARI KOISTINEN	365-428PCT	6270

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EXAMINER

EINSMANN, MARGARET V

ART UNIT PAPER NUMBER

1751

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/402,674

Applicant(s)

KOISTINEN ET AL.

Examiner

Margaret Einsmann

Art Unit

1751

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*Margaret Einsmann*  
Margaret Einsmann  
Primary Examiner  
Art Unit: 1751

09/402,674

Applicant's amendment filed 12/15/03 has been carefully considered but is not persuasive to moot the rejection of claims 17, 19-26 over Nakahara et al. as set forth in the previous office actions. Applicant states that it would not have been obvious to replace the NPG in example 10 of Nakahara with other esters or to use more than 50% HPHP as the polyol in the esters as is claimed. Applicant and Declarant refer to Table 4 in the specification which shows that as the proportion of HPHP is increased the solubility of the oil in fluorinated refrigerants is increased. Declarant points to esters comprising HPHP and BEPD which are set forth in the table and explains that as the proportion of HPHP in the HPHP/BEPD ester mixture is increased the solubility in fluorinated refrigerants is increased. Applicant is referred to claim 17, the independent claim now pending. Note that the mixture in the table is now claimed in the instant application. However, mixtures of HPHP with several other polyols is also claimed. The Table is not a proper comparison for the following reasons.

1. The mixtures in the examples all contain at least 50% HPHP as claimed. To overcome the rejection, the comparison should be with mixtures containing 50 mole % HPHP against mixtures containing more than 50%.
2. Applicant has not compared the closest art, Nakahara example 10.
3. The comparison should contain mixtures representative of the scope of the claimed subject matter so that there is probative value in the comparisons.

Accordingly that table cannot be used as evidence to support the claims which include mixed esters formed from at least 50 mole % HPHP mixed with trimethylol propane, trimethylol ethane, pentaerythritol or 2,2,4-trimethylpentadiol, and with many carboxylic acids. Regarding the discussion of the superiority of commercial HPHP over the HPHP used in Nakahara, the claims are inclusive of both types of HPHP. Accordingly the rejection is maintained.

